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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/696,206 | 10/26/2000 | Steven S. Kan | EM/KAN/6139 | 4283 |

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EXAMINER

SNAPP, SANDRA S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 02/23/2004

THIS ATTY HAS
09/969,206

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,206

Applicant(s)

KAN, STEVEN S.

Examiner

Sandra Snapp

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-17, 19-21, 24 and 27 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 18, 22, 23, 25, 26, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds the 150 word limit, it is too long. Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper. The patents have been considered by the Examiner and listed in the PTO-892 form, however in the future, if the Applicant would like such references to be considered, they should be submitted in a separate Information Disclosure Statement.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5, 6, 8, 9, 12, 14, 15, 17, 19, 20, 21, 24 and 27 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because in line 9, page 17, the phrase “a packet” should be “said packet” since the packet was previously identified in line 5.

Claim 1 is indefinite because in line 12, page 17, the phrase “a pairing element” should be “said pairing element” since the pairing element was previously identified in line 9.

Claim 1 is indefinite because in line 12, page, 17, the phrase “a matching table” should be “said matching table” since the matching table was previously identified in line 11.

Claim 1 is indefinite because in line 6, page 18, the phrase “the effectuated multiple transaction prices” lacks proper antecedent basis. Since this is the first occurrence of the element it should not be preceded by “the.”

Claim 2 is indefinite because it is confusing whether the users, buyers, sellers, traders, etc. are all the same, different or various combinations thereof. Clarification is required.

Claim 5 is indefinite because in line 25, page 18, the phrase “said account profile” lacks proper antecedent basis. This is the first occurrence of the element “account profile.” There was an account profile *database* previously identified, are they the same?

Claim 6 is indefinite because the phrase “the exchange server” in lines 29-30 on page 18 lacks proper antecedent basis. Since this is the first occurrence of the element it should not be preceded by “the.”

Claims 8 and 9 are indefinite because the phrase “for receiving trading requests from a remote buyer” is inconsistent with the “packet of trading requests” as previously recited in claim 1. Claim language should be consistent throughout the claims to avoid unnecessary confusion.

Claim 12 is indefinite because in line 10, page 19, the phrases “the matched result database” and “the unmatched result database” lack proper antecedent basis. Since this is the first occurrence of both elements, they should not be preceded by “the.”

Claim 14 is indefinite because in lines 15-16, page 19, the phrases “the corresponding total” and “the effectuated transaction prices” lack proper antecedent basis. Since this is the first occurrence of these elements, they should not be preceded by “the.” Also, it is unclear whether the “unmatched quantities” on line 17 are the same as the “unmatched results” as claimed in claim 1 or something different?

Claim 15 is indefinite because in line 19, page 19, the phrase “the aggregate market” lacks proper antecedent basis. Since this is the first occurrence of the element it should not be preceded by “the.” Also, is the “several trading indices” in line 20 the same as “several market indices” previously identified in line 8, page 18, claim 1? If so, the phrase should be preceded by “the”.

Claim 17 is indefinite because it is unclear whether the “packet of trading requests” in lines 27 and 29 on page 19 are the same or different. If they are the same, the second and subsequent occurrences thereof should be preceded by “the” or “said.” Also, in line 30, the phrase “from trading requests” should be “from *said* trading requests” since “trading requests” was previously identified in the claim. The phrases “the short side” and “the long side” in line 32 render the claim indefinite and should actually be “a short side” and “a long side” since this

was the first occurrence of each element. Also, on page 20, line 4, the phrase “sending trading information” is confusing because the Examiner is not sure whether the trading information being referred to is the same information as previously identified in line 28 on page 19, if so, it should be preceded by “the” or “said.”

Claim 19 is indefinite because in line 11 on page 20, the phrases “the receiving time” and “the request submission time” lack proper antecedent basis. They should not be preceded by “the” or “said” since this was the first occurrence for both elements. Also, in lines 11-12, the phrase “the trading requests” should be “the *packets of* trading requests” in order to be consistent with the claim language of claim 17.

Claim 20 is indefinite because the phrase “a remote trader” has previously been recited and therefore should be preceded by “the” or “said.”

Claim 21 is indefinite because the phrase “the request submission time” lacks proper antecedent basis.

Claim 24 is indefinite because it is unclear which “means” is being referred to in line 3 on page 21.

Claim 27 is indefinite because the phrases “the effectuated transaction prices”, “the trading information”, and “the aggregate market” all lack the proper antecedent basis. Since this is the first occurrence for each element, it should not be preceded by “the.”

Claim Rejections - 35 USC § 101

Claims 1, 3, 8-11, and 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack any recitation to a specific technology

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in the body of the claim, such as a computer, etc. According to the Board of Patent Appeals and Interferences, in the case *Ex parte Bowman*, the Board has taken the position that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological arts and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While this cases is not precedential, it is cited herein for its content and reasoning.

Allowable Subject Matter

Claims 2, 5, 6, 12, 17, 19, 20, 21, 24 and 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 4, 7, 18, 22, 23, 25, 26, 28 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record shows, discloses or teaches a method to effectuate multiple transaction prices for a commodity wherein pairing elements are paired in a matching table and the pairing elements are separated into two sides the buying side and the selling side, and summing the submitted quantities of each side's pairing elements, comparing the two, and designating the side of a smaller sum as the short side, and the side of the larger sum as the long side, as claimed in the present invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ausubel, Conlking et al., Barni et al., Aggarwal et al., Fisher et al., and Harrington et al. patents show various types of online auctions. The Silverman et al. patents are directed to electronic matching systems. The Ferstenberg et al. patent is for a commodities exchange system. The Broka et al. patent is for an electronic trading system. The Manasse and More et al., and Gilles et al. patents are for electronic commerce systems. The Odom et al. system is for an electronic exchange.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).